

## REMARKS

Claims 1-40 as filed in the patent application herein correspond to the claims 1-40 as were pending upon entry of Amendment A in the parent United States application number 09/280,919. Subsequent to the filing of Amendment A, an Office Action was mailed on April 7, 2003 for the parent case in which each of claims 1-37 and 40 were rejected. Upon entry of this preliminary amendment, claims 1-37 and 40 will be pending for examination, and correspond to the claims 1-37 and 40 of the parent case that were rejected. Although claims 1-37 and 40 were cancelled in the parent case, Applicants made clear that the cancellation was merely to expedite prosecution of the allowed claims. Applicants continue to maintain that claims 1-37 and 40 as were pending in the parent application, and as are now pending in this continuation patent application, are patentable over the cited art of record in the parent case. Accordingly, Applicants will now address the substance of the rejection in the parent case.

Specifically, the Office Action of the parent case rejected Claims 1-37 and 40 under 35 U.S.C. §103 as being obvious over United States patent number 5,870,464 issued to Brewster et al. (hereinafter referred to simply as “Brewster”) in view of United States patent number 5,948,069 issued to Kitai et al. (hereinafter referred to simply as “Kitai”) in view of United States patent number 5,627,517 issued to Theimer et al. (hereinafter referred to simply as “Theimer”).

The Manual of Patent Examining Procedure (MPEP) states as follows:

To establish a *prima facia* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. (See MPEP §2143, underlining added for emphasis).

Regarding Claim 1, the Office Action rightfully acknowledges that the combination of Brewster and Kitai “does not teach the message is to be sequentially distributed to a plurality of recipients in series, specified by the routing map, one after the other in a designated order.” However, the Office Action then asserts that Theimer describes this missing feature. Applicants respectfully traverse. In particular, the Office Action references column 11, lines 10-15 and lines

50-55; and column 12, lines 63-67 of Theimer. These cited passages have in common the recitation of “a sequence of location codes representative of a series of locations in the distribution system where the package is intended to be disposed”.

Theimer describes a mechanism that “relates to a decentralized package-tracking and routing system, for use in freight-handling and other distribution systems” (Column 1, lines 5-7). The package being delivered in the cited passages of Theimer is a physical package, not an electronic message at all. Claim 1 recites, among other things, an “electronic message being sequentially distributed to the plurality of recipients in a series specified by the routing map, one after the other in a designated order”. The Office Action acknowledges that the combination of Brewster and Kitai fails to teach or suggest this feature. Theimer also does not disclose the concept of an “electronic message being sequentially distributed to the plurality of recipients in a series specified by the routing map, one after the other in a designated order”. The Office Action seems to assume that the package referred to in the cited passages is indeed an electronic message, when that is not the case at all. Accordingly, the combination of Brewster, Kitai and Theimer do not teach or suggest all of the recited features of Claim 1 as required in order for a *prima facia* case of obviousness to stand against Claim 1 under established Federal Circuit case law.

Theimer is also non-analogous art as compared to the field of electronic message delivery. The problems and technical barriers for delivery of a physical package are fundamentally different than the problems and technical barriers for delivery of an electronic message. Accordingly, one attempting to solve the problems addressed by Claim 1 would not be naturally drawn towards the Theimer references. One of ordinary skill in the art of electronic message delivery would have no reasonable basis to believe that a solution applied to the technical field of freight delivery would also be successful in the context of electronic message delivery, and vice versa.

For example, electronic message may be replicated while the technology to replicate physical packages is not yet available and may never become available. Electronic messages require complex storage capability in order to even exist, while physical packages require nothing except their creation in order to exist. Electronic message delivery requires networks and complex protocols in order to be successful, while physical packages require nothing but the physical means to transfer the package from one location to another; hence physical object

movement predates electronic message delivery by millennia. Electronic message delivery may be accomplished rapidly without any human being knowing where the electronic message is at any point in time during the delivery process. On the other hand, freight delivery is typically slower, and thus there is sometimes a need for a human being to know where the package is in the distribution chain. In sum, to equate freight delivery with electronic message delivery trivializes the enormous differences faced by electronic message delivery and freight delivery. Certainly, even if one of ordinary skill in the art combined Theimer with Brewster and Kitai, the problems and technical barriers imposed by electronic message delivery are so different that freight delivery that it would not be apparent to one of ordinary skill in the art how to modify the Theimer reference so as to be usable with the technology disclosed by Brewster and Kitai.

In any case, even if a physical package were to be equated with an electronic message, the Theimer reference still does not teach sequential delivery to multiple recipients. In the context of the claim, there are multiple recipients of the electronic message. In the context of electronic message delivery, each recipient has access to at least some of the content of the electronic message and thus may perform tasks related to the content of the electronic message, and unrelated to the mechanism whereby the electronic message is delivered to the next participant. However, Theimer does not stand for the proposition that there are multiple recipients of a package. The only one that would typically have access to the package content would be a single final recipient, who would then open the package. Any intermediary nodes in the distribution chain for a physical package are not “recipients” at all as the term would be applied in the context of an electronic message, just as a router that facilitates delivery of an electronic message is not considered a recipient of the electronic message.

Each of the other independent claims are similar to Claim 1 to the extent that they recite sequential delivery of an electronic message in the context of other recited features. Accordingly, the other independent claims are not obvious over Brewster in view of Kitai, and in further view of Theimer for at least the reasons provided above for Claim 1. Furthermore, the dependent claims depend, directly or indirectly, from a corresponding one of the independent claims, and are thus not obvious over Brewster in view of Kitai, and in further view of Theimer for at least the reasons provided above for Claim 1. Therefore, reassertion of the same rejection against Claims 1-37 and 40 of the present patent application is not appropriate.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 11th day of July, 2003.

Respectfully submitted,



ADRIAN J. LEE  
Registration No. 42,785  
Attorney for Applicant



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